

**REMARKS**

Claims 1-4 and 6-23 are currently pending in the application. By this response, no claims are amended, added, or canceled. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

***35 U.S.C. §103 Rejection***

Claims 1-4 and 6-23 were rejected under 35 U.S.C. §103(a) for being unpatentable over U. S. Patent No. 6,061,660 issued to Eggleston *et al.* ("Eggleston") in view of U. S. Patent No. 5,586,198 issued to Lakritz ("Lakritz"). This rejection is respectfully traversed.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2142.

The Examiner asserts that Eggleston contains every feature of the claimed invention except for checking a database of promotions for presence of a promotion that includes the qualifying value. Applicants agree that Eggleston does not show this feature. Applicants also respectfully submit that Lakritz does not disclose this feature. Applicants further submit that Eggleston and Lakritz do not show many of the remaining features of the invention. Furthermore, Applicants note and disagree with the Examiner's Response to Arguments set forth on pages 2-5 of the outstanding Office Action. As such, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness because the applied references do not teach or suggest every element of the claimed invention and there is no motivation to combine.

The present invention relates generally to electronic commerce, and more particularly to commercial promotions provided by an electronic-commerce web server using compiled code. All of the independent claims 1, 2, 7, 11, 12, and 17 recite, *inter*

*alia*, "checking a database of promotions for presence of a promotion that includes the qualifying value". More specifically, exemplary claim 1 recites:

A method for enabling a web server to provide a commercial promotion, comprising the acts of:

detecting a qualifying value of a commercial transaction;

checking a database of promotions for presence of a promotion that includes the qualifying value; and

when a promotion that includes the qualifying value is present in the database, associating the qualifying value of the promotion with a module of selectively executable compiled web server code residing on a server's body of compiled code, selecting the module of selectively executable compiled web server code and executing the module of selectively executable compiled web server code that provides the promotion,

wherein the associating is made explicitly by pointers that are included in terms of the promotions.

Applicants agree with the Examiner's admission that Eggleston does not disclose checking a database of promotions for presence of a promotion that includes the qualifying value. Eggleston also does not disclose many other features of the claimed invention.

Eggleston discloses a system and method for conducting incentive programs and for fulfilling awards won in incentive programs, particularly incentive programs run over computer networks (col. 1 lines 20-26). In Eggleston the sponsor creates an incentive program and associates a *particular prize with the particular incentive program* (col. 15 lines 50-55). The sponsor may associate the prize with the incentive program by choosing the prize from an awards database 204 (col. 14 line 66 through col. 15 line 15). A consumer subsequently chooses to participate in the particular incentive program (col. 12 lines 40-55). The incentive program may be, for example, surveys, questionnaires, or games such as bingo, scratch-and-win, etc. (col. 19 lines 5-10). If a consumer successfully completes the incentive program, then the consumer is awarded the *particular prize* that is already associated with that *particular incentive program*. In other words, if a consumer performs task X then the consumer is awarded prize Y,

which is *predetermined*. There is no checking or searching of the award database 204 involved because the promotion (*i.e.*, award or prize) is *predetermined* when the consumer chooses a particular commercial transaction (*i.e.*, incentive program), and thus there is no reason to search a promotions database for a promotion that includes the qualifying value. Therefore, Eggleston does not teach checking a database of promotions for the presence of a promotion that includes the qualifying value, and there is absolutely no reason to add such capability to Eggleston.

Furthermore, Applicants respectfully submit that Eggleston does not teach or suggest when a promotion that includes the qualifying value is present in the database, associating the qualifying value of the promotion with a module of selectively executable compiled web server code, as recited in the claimed invention. As described above, Eggleston does not teach or suggest checking a promotions database because the promotion is pre-associated with the commercial transaction (*i.e.*, there is no need to check a database). Since Eggleston does not teach checking a promotions database, then Eggleston cannot teach a feature that is contingent upon a promotion being present (*i.e.*, found) in the promotions database. Thus, Eggleston does not teach associating the qualifying value of the promotion with a module of selectively executable compiled web server code when a promotion that includes the qualifying value is present in the database, as recited.

The associating step of the claimed invention provides an additional benefit of flexibility that is not present in the applied art. In the invention, a single qualifying value of the commercial transaction may be associated with any number of promotions in the promotions database. Thus, the step of associating provides the flexibility in the system of the invention to obtain an associated promotion which is not possible in the applied art. In the applied art, Eggleston teaches that a single promotion is pre-assigned to the commercial transaction. There is no way to change the assignment since they are already associated.

Contrary to the Examiner's assertion, Lakritz does not compensate for the deficiencies of Eggleston. Lakritz discloses a system that relates to symbol recognition and identification. Specifically, Lakritz discloses a look-up system for ideographic alphabets that allows the user to graphically describe a character of an alphabet by

building it out of its constituent components. The system includes a database that contains an index of constituent parts (*i.e.*, radicals) of ideographic characters (col. 10 lines 5-7). A user can select search criteria including a particular radical or the number of strokes in a character. The system will return all characters that match the search criteria (col. 5 line 62 though col. 6 line 4; figures 2-3). Lakritz does not teach or suggest checking a database of promotions for the presence of a promotion that includes a qualifying value (of a commercial transaction). To the contrary, Lakritz does not even mention a database of promotions or commercial transactions. Thus, the applied references do not teach or suggest every element of the claimed invention.

Furthermore, Lakritz does not teach or suggest associating the qualifying value of the promotion with a module of selectively executable compiled web server code when a promotion that includes the qualifying value is present in the database. Lakritz discloses an application that includes a user environment, graphical user interface, mouse, display screen, backend processor, window server and event handler, analysis engine, and database engine (col. 6 lines 52-65). The window server and event handler provide the connection between the user's actions on screen and the running program (col. 8 lines 28-30). Thus, it is clear that Lakritz does not disclose a web server and does not disclose a module of selectively executable compiled web server code residing on a server's body of compiled code. Therefore, it is impossible for Lakritz to teach or suggest associating the qualifying value of the promotion with a module of selectively executable compiled web server code when a promotion that includes the qualifying value is present in the database, as recited in the claimed invention. Thus, the applied references do not teach or suggest every element of the claimed invention.

Even assuming *arguendo* that Lakritz does contain one of the features missing in Eggleston, Applicants submit that there is no motivation to combine the references as asserted by the Examiner. As described above, Eggleston does not teach or suggest checking a promotions database because Eggleston's particular promotion is pre-associated with a particular commercial transaction (*i.e.*, there is no need to check a database). Therefore, even if Lakritz did show this feature, there would be no motivation to incorporate the feature in Eggleston. There simply is no reason to modify the Eggleston system to check a promotions database for a promotion with a qualifying

value, because the promotion is pre-determined when the sponsor pre-associates it with the incentive program.

Also, Applicants submit that there is no motivation to combine Eggleston and Lakritz because Lakritz is not analogous art. Eggleston is related to an internet-based incentive program involving sponsors, consumers, and retailers. Lakritz is related to a symbol recognition system that identifies characters in ideographic alphabets. The two fields are completely unrelated, and the skilled artisan concerned with modifying Eggleston would not look to Lakritz for guidance. Therefore, there is no motivation to combine the references.

Furthermore, Applicants note that independent claims 1 and 2 additionally recite, *inter alia*, associating made explicitly by pointers that are included in terms of the promotions. The Examiner is of the opinion that Eggleston discloses this feature in lines 1-20 of column 34. Applicants respectfully disagree.

Contrary to the Examiner's assertion, the pointer referred to Eggleston is a mouse pointer. Eggleston states that the front end graphical objects of the incentive program are connected to the code. The code makes the clicking of a pointer on a particular scratch-and-win game look like the consumer is actually scratching a surface (col. 33 line 66 through col. 34 line 5). Thus, it is clear that Eggleston is describing a mouse pointer (*i.e.*, cursor) in conjunction with on-screen graphics. Eggleston clearly is not describing a pointer such that the associating is made explicitly by pointers that are included in terms of the promotions, as recited in claims 1 and 2. Therefore, the applied references do not teach or suggest every element of the claimed invention.

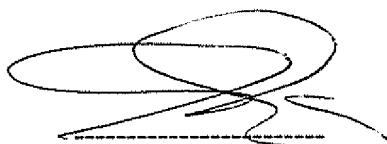
In view of the above, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness because Eggleston and Lakritz do not teach or suggest all of the features of independent claims 1, 2, 7, 11, 12, and 17. As to the dependent claims, Applicants submit that claims 3, 4, 8-10, 13-16, and 18-23 depend from an allowable independent claim and are allowable based on the allowability of the independent claim.

Accordingly, Applicants respectfully request that the rejection over claims 1-4 and 6-23 be withdrawn.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,  
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